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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,233	06/20/2003	Leslie B. Herbert	86656RRS	9186

7590 01/09/2007  
Milton S. Sales  
Patent Legal Staff  
Eastman Kodak Company  
343 State Street  
Rochester, NY 14650-2201

EXAMINER
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KASSA, YOSEF

ART UNIT	PAPER NUMBER
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2624

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/601,233

Applicant(s)

HERBERT ET AL.

Examiner

YOSEF KASSA

Art Unit

2624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 15-17 is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-14 and 18-31 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 10/03, 11/04.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-5, 7-14, 18-20 and 24-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Umezawa (U.S. Patent 5,784,484), and further in view of Cloutier et al (U.S. Patent 6,018,397).

With regard to claim 1, Umezawa discloses determining a selection area within the digital image (please refer to col. 2, lines 38-42);

determining a preferred output image form for rendering an image comprising the selected area of the digital image (refer to col. 4, lines 6-9), with the determination being based upon an image resolution of the digital image (refer col. 5, lines 6-20), the determined selection area and an output resolution associated with each output form (refer col. 4, lines 23-34).

Umezawa does not disclose expressly for indicating the preferred output image form. However, at the same field of endeavor, Cloutier discloses this feature (please refer to col. 3, lines 41-46). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching Cloutier output image processing system into Umezawa system. The suggestion/motivation for doing so would

have been to provide an output which represents the assessment of the level of image quality that would be reproduced by a given output device (refer to col. 3, lines 39-42 of Cloutier). Therefore, it would have been obvious to combine Cloutier with Umezawa to obtain the invention as specified in claim 1.

With regard to claim 2, Umezawa discloses wherein the selection area is adjustably selected and wherein the indicated preferred output image form is adjusted based upon adjustments to the selection area (refer to col. 3, lines 20-27).

With regard to claim 3, Umezawa discloses wherein the selection area is adjustably selected and wherein the indicated preferred output image form is adjusted at substantially the same time that the selection area is adjustably selected (refer col. 4, lines 3-20).

With regard to claim 4, Umezawa discloses wherein the step of determining the preferred output image forms is based upon the output image rendering capabilities of an image rendering device (refer col. 4, lines 20-26).

With regard to claim 5, Umezawa discloses further comprising the step of determining an intended output image rendering device and wherein the step of determining the preferred output image form is determined based upon the output image rendering capabilities of the intended image rendering device (refer col. 4, line 23-33).

With regard to claim 7, Umezawa discloses wherein the indication comprises at least one of a video, text, printed, audio or tactile signal (refer col. 4, line 3-9).

With regard to claim 8, Umezawa fail to discloses the indication comprises an indication of a maximum preferred output size associated with a determined selection area. However, at the same field of endeavor, Cloutier discloses this feature (please refer to col. 3, lines 35-46). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching Cloutier magnification selection system into Umezawa system. The suggestion/motivation for doing so would have been to provide print size and aspect ratio for a given magnification selection will result in a suitable hardcopy image quality (refer to col. 3, lines 39-42 of Cloutier).

Claim 9 is similarly analyzed and rejected the same as claims 1.

Claim 10 is similarly analyzed and rejected the same as claims 1 and 8.

With regard to claim 11, Umezawa discloses wherein the determination is based upon predetermined image rendering capabilities of more than one imaging device (refer Fig. 1).

With regard to claim 12, Umezawa discloses wherein the determination based is upon predetermined image rendering capabilities (refer col. 4, lines 15-20).

With regard to claim 13, Umezawa discloses further comprising the steps of receiving a signal indicating that an image is to be formed using the selection area, and forming an image using only the image information from the selection area, wherein the step of forming the image comprises forming an image having a size substantially similar to the size of the original image (refer col. 4, line 15-23).

With regard to claim 14, Umezawa discloses further comprising the step of presenting a request for authorization to form a second image based upon the portions of the digital image in the selected area (refer col. 4, lines 34-45).

Claim 18 is similarly analyzed and rejected the same as claim 1.

Claims 19 and 20 are similarly analyzed and rejected the same as claims 2 and 3.

Claim 24 is similarly analyzed and rejected the same as claim 1 and 9. Except, the additional limitation "an indicating system having human detectable indications of preferred image output forms, and a user interface system". However, at the same field of endeavor, Cloutier discloses this feature (please refer to col. 3, lines 41-46). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to incorporate the teaching Cloutier output image processing system into Umezawa system. The suggestion/motivation for doing so would have been to provide an output which represents the assessment of the level of image quality that would be reproduced by a given output device (refer to col. 3, lines 39-42 of Cloutier).

Claim 25 is similarly analyzed and rejected the same as claim 9.

Claim 26 is similarly analyzed and rejected the same as claim 8.

With regard to claim 27, Umezawa discloses wherein the controller generated image is generated only after the indication is presented and an authorization to generate the image is received (refer col. 4, lines 9-15).

With regard to claim 28, Umezawa discloses further comprising a communication module adapted to exchange digital images with another device (refer Fig. 1).

Claim 29 is similarly analyzed and rejected the same as claim 24.

Claim 30 is similarly analyzed and rejected the same as claim 9.

Claim 31 is similarly analyzed and rejected the same as claim 8.

### ***Allowable Subject Matter***

2. Claims 15-17 are allowed.

The following is an examiner's statement of reasons for allowance: receiving subsequent selection area designations within the digital determining a preferred output image form for rendering an image containing portions of the digital image that are within each subsequently designated selection area based upon the image resolution, the selection area and a predetermined resolution of at least one image output form, and indicating the preferred output image form for each subsequent area designation.

Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claims 21-23 defines a "a computer program product for..." embodying functional descriptive material. However, the claim does not define a computer-readable medium or memory and is thus non-statutory for



that reason (i.e., "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized" – Guidelines Annex IV). That is, the scope of the presently claimed "a computer program product for..." can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on "computer-readable medium" or equivalent in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

#### ***Other Prior Art Cited***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. (6628829), (5926568), (5828406) and (6243131).

#### ***Conclusion***

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to YOSEF KASSA whose telephone number is (571) 272-7452. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew Bella can be reached on (571) 272-7778. The fax phone numbers

Art Unit: 2624

for the organization where this application or proceeding is assigned is (571) 273-8300 for regular communication and (571) 273-8300 for after Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the customer service office whose telephone number is (571) 272-2600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**PATENT EXAMINER**

Yosef Kassa

01/05/2007.

A handwritten signature in black ink, appearing to read 'Y. Kassa', is written over a vertical line.